

**Neifeld Docket No: TACT0001**

Application No. : 09/666,068 Confirmation No. 6420  
Patent No. : 6,379,666 Issued April 30, 2002  
Applicant : Edward L. Tobinick  
Filed : 12/11/2000  
TC/A.U. : 1614  
Examiner : Jarvis, William R. A.

Supplemental 37 CFR §1.78 Petition for Acceptance of an Unintentionally Delayed  
Claim for Priority

and Petition for Entry of an Amendment to the Specification in an Issued Application

This is a Supplemental Petition to accept an unintentionally delayed claim of priority under 37 CFR 1.78(a)(3). The entire delay between the date the priority claim was due under paragraph 37 CFR 1.78 (a)(2)(ii) and the date of submission of this Petition was unintentional.

This petition replaces the one filed 3-30-2010, and corrects typographical errors in section III. B. Specifically, application serial number "09/666,068" is corrected to "09/275,070" and a citation to Exhibit 1 is corrected to Exhibit 11. All corrections below are underlined. There are no new exhibits and this petition relies on the exhibits filed March 30, 2010.

The fee required by 37 CFR 1.17(t) was submitted on March 30, 2010.

An amendment to the specification correcting the reference to related applications was submitted on March 30, 2010.

A draft Certificate of Correction for U.S. 6,379,666 and the fee required by 37 CFR 1.20(a) were submitted on March 30, 2010

All of the elements required under 37 CFR 1.78(a)(3) have been presented, thus awarding a corrected priority chain in application Ser. No. 09/666,068 is proper.

## **I. STATEMENT OF THE RELIEF REQUESTED**

The applicant petitions for acceptance of an unintentionally delayed claim for priority and for entry into this issued application of an amendment to correct the benefit claim under 35 U.S.C. §120.

The chain of priority in 09/666,068 is missing a reference to application 09/275,070. As explained below, the priority chain should refer to 09/275,070 between 09/476,643 and 09/256,388, and it should specify that 09/476,643 is a continuation-in-part of 09/275,070.

In an amendment submitted herewith, page 1 of the specification (the paragraph starting with "RELATED APPLICATIONS") is amended as follows (marked-up):

This application is a divisional of Ser. No. 09/476,643, filed Dec. 31, 1999, now U.S. Pat No. 6,177,077, which is a continuation-in-part of Serial No. 09/275,070, filed March 23, 1999, now U.S. Pat No. 6,015,557, which is a continuation-in-part of application Ser. No. 09/256,388, filed on Feb. 24, 1999, now abandoned.

## **II. MATERIAL FACTS**

### **A. CHAIN OF APPLICATION FILINGS**

1. On February 24, 1999, the applicant filed Serial No. 09/256,388, with an original U.S. inventor declaration.

2. On September 16, 1999, applicant filed a notice of express abandonment that stated:

"Re: S.N. 09/256,388 Applicant hereby abandons the above-identified application in favor of Appln. S.N. 09/275,070, which has been allowed by Examiner Jarvis."

3. Serial No. 09/275,070 was filed on March 23, 1999, and matured into U.S. 6,015,557 on January 18, 2000. The applicant filed an original U.S. inventor declaration in 09/275,070, which specifically referred to S.N. 09/256,388.

4. Applicant filed Serial No. 09/476,643 on December 31, 1999, which is prior to January 18, 2000, and was therefore co-pending with S.N. 09/275,070. Applicant filed an original U.S. inventor declaration attached to the specification in 09/476,643 that did not refer to any prior applications.

5. Page 1 of the '643 specification, under the heading "RELATED APPLICATION" stated erroneously that "This is a continuation-in-part of Application Serial No. 09/256,388, filed on February 24, 1999." This statement is erroneous because 09/256,388 had been expressly abandoned on September 16, 1999 (before the '643 application was filed) in favor of 09/275,070 which was still pending when the '643 application was filed.

6. On July 21, 2000, applicant filed a "new" (i.e., a second) original U.S. inventor declaration in 09/476,643 that specifically refers to 09/256,388 and to 09/275,070, thus correcting priority and preserving co-pendency throughout all applications in the chain.

7. Serial No. 09/476,643 matured into U.S. 6,177,077 on January 23, 2001. On page 1 of the patent specification, as amended on July 21, 2000, it states "This application is a continuation-in-part of Ser. No. 09/275,070, filed March 23, 1999, now U.S. Pat No. 6,015,557, which is a continuation-in-part of application Ser. No. 09/256,388, filed on Feb. 24, 1999, now abandoned."

7. Applicant first filed the subject divisional (Ser. No. 09/666,068) on September 19, 2000, but later was accorded an official filing date of December 11, 2000, which however is still prior to January 23, 2001. Thus divisional 09/666,068 was co-pending with its parent application 09/476,643. The applicant filed the same inventive specification, a copy of the U.S. inventor declaration from 09/476,643, and relied upon that copy of the original inventor declaration to secure the December 11, 2000 filing date.

8. On 12/06/2000, applicant filed a request for Correction of Filing Receipt stating erroneously: "THIS APPLICATION IS A DIV OF 09/476,643, DATED 12/31/1999, WHICH IS A CIP OF 09/256,388, DATED 2/24/1999, ABANDONED." This statement is erroneous because 09/476,643 is actually a continuation-in-part of Ser. No. 09/275,070, and cannot be a continuation-in-part of 09/256,388, due to lack of co-pendency, as explained above.

9. On 11/15/2001, the Related Application statement on page 1 of subject application 09/666,068 was amended by the Examiner (as indicated by handwritten, dated initials) to add the following underlined text: "This application is a divisional of Ser. No. 09/476,643, filed Dec. 31, 1999, now U.S. Pat No. 6,177,077, which is a continuation-in-part of Application Ser. No. 09/256,388, filed on Feb. 24, 1999, now abandoned." This statement is erroneous because

09/476,643 is actually a continuation-in-part of Ser. No. 09/275,070, and cannot be a continuation-in-part of 09/256,388, due to lack of co-pendency, as explained above.

11. On 02/22/2001, an Official Filing Receipt was issued in 09/666,068 stating "THIS APPLICATION IS A DIV OF 09/476,643, 12/31/1999, PAT 6,177,077 WHICH IS A CIP OF 09/256,388, 2/24/1999, ABANDONED." This statement is erroneous because 09/476,643 is in fact a continuation-in-part of Ser. No. 09/275,070, and cannot be a continuation-in-part of 09/256,388, due to lack of co-pendency, as explained above.

12. So in 09/666,068, the applicant's request for Correction of Filing Receipt (12/06/2000), the Examiner's amendment to the specification (11/15/2001), and the Official Filing Receipt (03/22/2001) are all incorrect. That is because 09/476,643 is actually a continuation-in-part of Serial No. 09/275,070, while 09/275,070 is a CIP of 09/256,388.

13. As a result of these facts the 09/666,068 application contains an erroneous priority chain.

#### **B. USPTO RECORDS SHOWING THE BENEFIT CLAIM IN 09/666,068**

14. Exhibit 1 is a copy of the 2 page transmittal letter, and page 1 of the specification filed on 09/19/2000 in application 09/666,068. The upper left hand corner of Exhibit 1 has a USPTO date stamp showing "09/19/00" The upper right hand corner shows the USPTO application number "09/666,068."

15. Exhibit 1, pages 1 and 2, indicate that 09/666,068 was filed as a Rule 60 divisional incorporating the prior specification and inventor declaration. Item 8 is checked, and amends the specification before the first line to recite "division of application number 09/476,643, filed Dec. 31, 1999."

16. Exhibit 1 page 3 shows the original first sentence of the specification, i.e., "This is a continuation-in-part of application Serial No. 09/256,388, filed on February 24, 1999" along with the Examiner's handwritten amendment dated 11/15/2001, revising the priority claim to recite "This application is a divisional of Ser. No. 09/476,643, filed Dec. 31, 1999, now U.S. Pat No. 6,177,077, which is a continuation-in-part of Application Ser. No. 09/256,388, filed on Feb. 24, 1999, now abandoned." (marked-up)

17. Exhibit 2, pages 1 and 2 shows the applicant filed a copy of the original U.S. inventor declaration from 09/476,643, signed by Edward L. Tobinick, M.D. on December 29, 1999, and relied upon that copy to secure the December 11, 2000 filing date.

18. Exhibit 2, page 3 shows applicant requested a correction of filing receipt, dated-stamped "12/06/2000," in stating erroneously: "THIS APPLICATION IS A DIV OF 09/476,643, DATED 12/31/1999, WHICH IS A CIP OF 09/256,388, DATED 2/24/1999, ABANDONED."

19. Exhibit 3, pages 3 - 4 show a two page transmittal letter, date-stamped "Dec 11, 2000" filed in response to the Notice to File Missing Parts, listing "A copy of the Declaration from the parent application (U.S. Serial No. 09/476,643)".

20. Exhibit 3, pages 1 is a Official Filing Receipt mailed "01/24/2001." Exhibit 3, page 2 is an Official Filing Receipt mailed "02/22/2001."

21. Application 09/666,068 issued as USP 6,379,666.

22. Exhibit 4 is a printout of the first two columns of USP 6,379,666.

23. Exhibit 4 shows that the first sentence of USP 6,379,666 recites "This application is a divisional of Ser. No. 09/476,643, filed Dec. 31, 1999, now U.S. Pat No. 6,177,077, which is a continuation-in-part of application Ser. No. 09/256,388, filed on Feb. 24, 1999, now abandoned."

24. **The foregoing facts show that the USPTO records show that application 09/666,068 is a divisional of 09/476,643.**

### C. USPTO RECORDS SHOWING THE BENEFIT CLAIM IN 09/476,643

25. Exhibit 5, pages 1 and 2 shows the original inventor declaration from application 09/476,643, signed by Edward L. Tobinick, M.D., on December 29, 1999. Exhibit 5, page 3 is the first page of the PTO file history for application 09/476,643, stating in the examiner's handwriting verification that "THIS APPLN is a CIP OF 09/275,070 03/23/99 PAT 6,015,557 WHICH IS A CIP OF 09/256,388 02/24/99 ABN"

26. Exhibit 6, page 1 is a one page transmittal letter dated "December 31, 1999 BY EXPRESS MAIL" for a new application showing the filing of an original inventor's declaration. At the upper left is the date "12/31/99" and at the upper right is the serial number "09/476643". Exhibit 6, page 2 shows the first page of the specification, which one can see originally said

"This is a continuation-in-part of Application Serial No. 09/256,388, filed on February 24, 1999." This sentence was crossed-out by the examiner.

27. Exhibit 7, page 1 is the first page of the PTO File History, amended in handwriting by the examiner to state "This Appln is a CIP OF 09/275,070 PAT #6,015,557 WHICH IS A CIP OF 09/256,388 02/24/99 ABN." Exhibit 7, page 2 is another copy of the one page transmittal letter dated "December 31, 1999 BY EXPRESS MAIL" for a new application showing the filing of an original inventor's declaration. At the upper left is the date "12/31/99" and at the upper right is the serial number "09/476643". Exhibit 7, page 3 is an inventor declaration filed with the application. Exhibit 7, page 4 shows the first page of the specification as filed, which stated "This is a continuation-in-part of Application Serial No. 09/256,388, filed on February 24, 1999". This sentence was later crossed-out by the examiner.

28. Exhibit 8, page 1 is a Terminal Disclaimer over US 6,015,557, and page 2 is an original inventor declaration claiming benefit of application "09/275,070 March 23, 1999 U.S. Patent No. 6,015,557" and "09/256,388 February 24, 1999 Abandoned"

29. Exhibit 9, page 2 shows the handwritten amendment by the examiner, dated 8/24/2000 changing the first sentence of the specification to recite "'This application is a continuation-in-part of Application Serial No. 09/275,070, filed on March 23, 1999, now U.S. Patent 6,015,557, which is a continuation-in-part of Application Ser. No. 09/256,388, filed on February 24, 1999, now abandoned"

30. Exhibit 10 is a printout of the first two columns of US 6,177,077, stating in the first paragraph that "This application is a continuation-in-part of Application Serial No. 09/275,070, filed on Mar 23, 1999, now U.S. Pat. No. 6,015,557, which is a continuation-in-part of Application Ser. No. 09/256,388, filed on Feb. 24, 1999, now abandoned."

31. **The foregoing facts show that the USPTO records show that application 09/476,643 was a continuation-in-part of 09/275,070.**

#### **D. USPTO RECORDS SHOWING THE BENEFIT CLAIM IN 09/275,070**

32. Exhibit 11, page 1 is a transmittal letter dated "March 23, 1999 BY EXPRESS MAIL." Page 2 is the first page of the specification as filed.. Pages 3 and 4 are a copy of the original inventor declaration, claiming benefit under 35 USC 120 to "09/256,388 24 February 1999

pending" signed on 3-20-99 by two inventors, Dr. Edward L. Tobinick, and Arthur Jerome Tobinick. Pages 5 -8 are a copy of a Petition to Make Special filed March 23, 1999. At the upper right on page 5 is the serial number "09/257070" and the date "03/23/99".

33. Exhibit 12 is a printout of the first two columns of US 6,015,557, stating in the first paragraph that "This application is a continuation-in-part of Application Ser. No. 09/256,388, filed on Feb. 24, 1999, now abandoned."

34 **The foregoing facts show that the USPTO records show that application 09/275,070 was a continuation-in-part of 09/256,388.**

#### **E. USPTO RECORDS SHOWING THE FILING DATE OF 09/256,388**

35 Exhibit 13, page 3 is a copy of the first page USPTO file history for application 09/256,388, showing "FILING DATE 02/24/99." Pages 1 - 2 show the original inventor declaration, dated February 21, 1999, signed by two inventors, Dr. Edward L. Tobinick, and Arthur Jerome Tobinick. In 09/256,388, inventor "Edward L. Tobinick, M.D." is the same person as "Dr. Edward L. Tobinick" in 09/275,070 (and "Edward L. Tobinick, M.D." in 09/476,643).

36. Exhibit 14 is another copy of the inventor declaration. Page 2 is transmittal letter dated "FEBRUARY 24, 1999 BY EXPRESS MAIL" listing the filing of an inventor declaration, and specification. Page 3 of Exhibit 14 is the first page of the specification as filed.

37. Exhibit 15, pages 1 - 2 is a Notice of Abandonment "mailed 09/27/99." Exhibit 15, page 3 is communication by applicant dated 9/16/99 stating: "Re: S.N. 09/256,388 Applicant hereby abandons the above-identified application in favor of Appln. S.N. 09/275,070, which has been allowed by Examiner Jarvis."

38 **The foregoing show that the USPTO records show that application 09/256,388 was filed on February 24, 1999 and abandoned on Sept. 16, 1999.**

#### **F. FACTS WHY THE REQUESTED RELIEF IS NOT MOOT**

39. Pending Tobinick application 12/714,205 claims priority to 09/666,068 as "a continuation of application Serial No. 11/262,528, filed on Oct. 28, 2005, which is a division of application Ser. No. 10/269,745, filed Oct. 9, 2002, now U.S. Pat. No. 6,982,089, which is a

continuation-in-part of application Ser. No. 09/841,844, filed on Apr. 25, 2001, now U.S. Pat. No. 6,537,549, which is a continuation-in-part of application Ser. No. 09/826,976, filed on Apr. 5, 2001, now U.S. Pat. No. 6,419,944, **which is a continuation-in-part of application Ser. No. 09/666,068, filed Dec. 11, 2000, now U.S. Pat. No. 6,379,666, which is a division of application Ser. No. 09/476,643, filed on Dec. 31, 1999, now U.S. Pat. No. 6,177,077, which is a continuation-in-part of application Ser. No. 09/275,070, filed on Mar. 23, 1999, now U.S. Pat. No. 6,015,557**, which is a continuation-in-part of application Ser. No. 09/256,388, filed on Feb. 24, 1999, now abandoned.” (emphasis added)

#### **G. FACTS SHOWING THE FAILURE TO PROPERLY CLAIM BENEFIT WAS UNINTENTIONAL**

40 The foregoing facts 1 - 39 show that failure to claim in this application priority to 09/666,068 was an unintentional clerical error.

#### **H. FACTS RELATING TO THE LEGAL STANDARD FOR ENTRY OF CORRECTION OF BENEFIT CLAIMS**

41 Exhibit 16 is a copy of pages from Section 1481.03 of the current version of the MPEP.

#### **I. RELATED USPTO PROCEEDINGS**

42. The applicant is presenting herewith an Amendment to correct benefit in prior application 09/666,068.

43. The applicant is filing herewith a corresponding request for a certificate of correction in the patent that issued from this application, U.S. Pat. 6,379,666.

### **III. REASONS WHY THE PETITION SHOULD BE GRANTED**

On the merits, the petition should be granted because (1) the relief requested is not moot; (2) an amendment as to benefit in an issued application is submitted herewith, (3) all of the elements required under 37 CFR 1.78(a)(3) have been presented, so awarding a corrected priority chain in application Ser. No. 09/666,068 is proper, and (4) a request for the appropriate Certificate of Correction has been filed.

**A.. STANDARD FOR GRANT OF PETITION**

**I. FORMAL MATTERS**

This petition requests entry of an amendment in an issued application filed after November 29, 2000. Therefore petition under Rule 1.78 is proper.

(CX13 "Eighteen-Month Publication Questions and Answers"

<http://www.uspto.gov/patents/law/aipa/18month/18monthfaq.jsp#cx>)

The applicant is paying the 37 CFR 1.17(t) fee therefore via credit card upon EFS web submission of this petition.

**2. THE PETITION IS NOT MOOT**

The petition is not moot because, even though 09/666,068 is issued, a pending application claims priority to this application. Fact 39.

**3. CRITERIA FOR CORRECTION OF BENEFIT**

The amendment that this petition requests be entered corrects benefit. The requirements to obtain benefit and to correct benefit are governed by Rule 1.78. MPEP 1481.03 contains criteria for granting a certificate of correction correcting benefit in an issued patent. See the section titled "Correction of 35 U.S.C. 119 and 35 U.S.C. 120 Benefits." In view of the foregoing, this petition shows compliance with the criteria for correction of benefit under Rule 1.78.

**B. THE APPLICANT HAS COMPLIED WITH THE CRITERIA FOR CLAIMING BENEFIT TO 09/275,070 (corrections are underlined)**

**I. THE APPLICANT HAS COMPLIED WITH THE REQUIREMENTS OF 37 C.F.R. 1.78**

The following paragraphs in this subsection identify requirements in Rule 1.78 for claiming priority, and show compliance with those requirements.

37 CFR 1.78(a)(1) authorizes a claim to priority to prior filed applications only if the applications name at least one common inventor and disclose the claimed invention. The prior filed application is 09/275,070. The common inventor is Edward L. Tobinick, M.D. Facts 14-39.

37 CFR 1.78(a)(1)(i) and (ii) require the prior filed applications to be either international applications or applications entitled to a filing date. The prior filed applications is 09/275,070, which was entitled to and accorded a filing date. Exhibit 11, Facts 32 - 34.

37 CFR 1.78(a)(2)(i) requires a claim to priority to be present or amended to be present during the pendency of the application, unless the application was filed prior to November 29, 2000, and to state the relationship between the applications. This application is an application filed under 111(a) after November 29, 2000. Accordingly, the amendment submitted herewith provides the specific references and relationships to 09/476,643, which is a continuation-in-part of 09/275,070, which is a continuation-in-part of 09/256,388.

37 CFR 1.78(a)(2)(iii) requires the claim to priority be presented in an application data sheet or amendment to the first sentence of the specification following the title. The amendment submitted herewith provides the claim to priority to 09/275,070 in the first sentence of the specification following the title.

37 CFR 1.78(a)(3) authorizes an amendment claiming priority after the time periods specified by 1.78(a)(2)(ii) only if the late filing of the claim the priority was unintentionally delayed. The entire delay between the date the priority claim was due under paragraph 37 CFR 1.78 (a)(2)(ii) and the date of submission of this Petition was unintentional. Fact 40.

37 CFR 1.78 contains no other requirements applicable to grant of this petition. In view of the foregoing, this petition should be granted.

**DATE:** 5-19-2010

**SIGNATURE:** /RobertHahl#33,893/

**PRINTED NAME:** Robert W. Hahl, Ph.D.

Date/time code: May 19, 2010 (4:09pm)

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